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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,048	02/03/2006	Artur Lachowicz	S9025.0209	7390

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DICKSTEIN SHAPIRO LLP  
1633 Broadway  
NEW YORK, NY 10019

EXAMINER
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BOYLE, ROBERT C

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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07/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,048	<b>Applicant(s)</b> LACHOWICZ ET AL.	
	<b>Examiner</b> ROBERT C. BOYLE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The new grounds of rejection set forth below are NOT necessitated by applicant's amendment filed on 5/10/2010. Thus, the following action is properly made NON-FINAL. Reconsideration of the limitation of the 'curable liquid' and a search update which uncovered relevant new art prompted the new grounds of rejection. The delay in prosecution is regretted.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

4. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "A curable liquid acryloyl group containing resin composition" and "wherein the resin composition is a curable liquid." The second "curable liquid" recitation makes it unclear as to whether the limitation is redundant, and simply emphasizes that the composition is liquid and curable, or whether the second "curable liquid" recitation is intended to add a limitation that is outside the scope of the first "curable liquid" recitation, such as the acryloyl group itself is liquid and curable. Because the repetition of "curable liquid" is repeated and creates confusion, the scope of the claim is indefinite.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

7. A person shall be entitled to a patent unless –

8. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Dammann (US 6,706,414).

10. As to claims 1-3, 31, Dammann teaches liquid, curable compositions of the Michael reaction product of an acetoacetate compound with a multifunctional acrylate compound (abstract). Example 6 of Dammann teaches 74 g of trimethylol propane triacrylate (b), 14.8 g of ethyl acetoacetate (c), and 5 wt % of glycidyl methacrylate (a) are combined and reacted together (col. 10-col. 11). The amounts of the reactants added fall within the claimed equivalent ratios: the ratio of glycidyl methacrylate to the active hydrogens of ethyl acetoacetate is 0.14 : 1, and the ratio of the unsaturated groups of glycidyl methacrylate and trimethylol propane triacrylate to the active hydrogens of ethyl acetoacetate is 4.1:1.

11. As to claims 4-5, 9, 32, glycidyl methacrylate has an epoxy group (col. 10, ln. 49).

12. As to claim 6, Dammann teaches the process of reacting trimethylol propane triacrylate, glycidyl methacrylate, and trimethylol propane triacrylate in amounts that fall within the claimed equivalent ratios (col. 10, ln. 9-49; Table 1).

13. As to claim 7, while Dammann does not teach the order in which the reaction occurs. However, as the reactants are all added into the same reactor at apparently the same time, at least

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a portion of the ethyl acetoacetate must react with the glycidyl methacrylate prior to reaction with the trimethylol propane triacrylate.

14. As to claim 8, the amounts of the reactants satisfy the claimed equivalent ratios (see ¶ 8 above).

15. As to claims 10, 33, reaction takes place in the presence of a catalyst (col. 3, ln. 20-42).

16. As to claims 11-30, Dammann teaches curing by ultraviolet light without the need of a photoinitiator (col. 7, ln. 48-57) to result in cured products (col. 2, ln. 38-42).

### ***Response to Arguments***

17. Applicant's arguments with respect to the reference Rheinberger have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Dammann (US 6,706,414).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT C. BOYLE whose telephone number is (571)270-7347. The examiner can normally be reached on Monday-Thursday, 9:00AM-5:00PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert C. Boyle/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796